

1643
#4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Terry Strom et al.
Serial No. : 09/778,013
Filed : February 6, 2001
Title : METHODS OF EVALUATING TRANSPLANT REJECTION

Art Unit : 1645
Examiner :

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JUL 19 2002

TECH CENTER 1600/2900

Commissioner for Patents
Washington, D.C. 20231

REVOCATION AND NEW POWER OF ATTORNEY

Under 37 CFR §3.73 (b) BETH ISRAEL DEACONESS MEDICAL CENTER, INC., a corporation, and CORNELL RESEARCH FOUNDATION, INC. a corporation, certify that they are the assignees of 100% of the right, title and interest in the patent application identified above by virtue of:

☒ Assignments from the inventors of the patent application identified above. The assignments are pending recordation in the Patent and Trademark Office (copies enclosed).

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of the undersigned's knowledge and belief, title is in the assignees identified above.

The undersigned, whose title is supplied below, are empowered to act on behalf of the assignees.

The undersigned, acting on behalf of the assignee, hereby revokes all powers of attorney previously granted in the application and appoints:

LEE CREWS, Ph.D.
Reg. No. 43,567
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804

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CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit

Signature

Typed or Printed Name of Person Signing Certificate

July 10, 2002

Mary E. Jacoby

Mary E. Jacoby

with full power of substitution and revocation, to prosecute the application and to transact all business in the United States Patent and Trademark Office connected therewith.

All correspondence regarding the application should be sent to:

LEE CREWS, Ph.D.
Reg. No. 43,567
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patents issued thereon.

Respectfully submitted,

BETH ISRAEL DEACONESS MEDICAL
CENTER, INC.

Date: _____

Mark Chalek
Chief, Business Ventures

CORNELL RESEARCH FOUNDATION, INC.

Date: *x May 16, 2002* _____

x James A. Severson

By: James A. Severson
Title: President

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906



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Respectfully submitted,

BETH ISRAEL DEACONESS MEDICAL
CENTER, INC.

Date: 4/11/02


Mark Chalek
Chief, Business Ventures

CORNELL RESEARCH FOUNDATION, INC.

Date: _____

By: _____
Title: _____

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JOINT INVENTION AGREEMENT

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This Agreement is effective as of July 1, 1997 (the "Effective Date") by and between Cornell Research Foundation, 20 Thornwood Drive, Suite 105, Ithaca, New York, 14850 ("CRF") and Beth Israel Deaconess Medical Center, 330 Brookline Ave., Boston, MA 02215 ("Medical Center").

WHEREAS, CRF and Medical Center jointly own by assignment the Invention entitled "Methods of evaluating transplant rejection," (hereinafter referred to as "INVENTION") including the devices, machines, methods, processes, manufactures, compositions of material as described in the patent and patent applications listed in the INVENTION Description attached as Appendix A.

WHEREAS, CRF and Medical Center wish to license the INVENTION in the most expeditious manner for the public benefit;

NOW, THEREFORE, in consideration of the promises and the mutual covenants contained herein, the parties agree as follows:

1. Responsibility for Patent Prosecution. CRF hereby appoints Medical Center to manage the patent prosecution of the INVENTION. CRF will be consulted on patent prosecution and copied on all patent correspondence. CRF shall use reasonable efforts to assure full cooperation of its inventors in the preparation, filing, prosecution, and maintenance of such patents.

2. Responsibility for Licenses. CRF hereby appoints Medical Center their agent to diligently locate an appropriate licensee, negotiate reasonable license terms, and execute a license agreement for the commercialization of the INVENTIONS. CRF will have the right to review, comment upon and approve any proposed license agreement or amendment thereto, prior to its signature. CRF agrees that its approval will not be withheld due to reasonable financial terms of the agreement. Medical Center will provide a copy to CRF of any fully-executed license agreement or amendment, and upon request will provide a copy of other significant correspondence. Both parties shall retain the right to use this INVENTION for research, education and patient care purposes.

3. Patent Costs. Medical Center and CRF will share all reasonable out-of-pocket expenses including attorney's fees, incurred in marketing the INVENTION and in the filing, prosecution, and maintenance of patent rights for the INVENTION in the United States and foreign countries selected by Medical Center or the licensee and shall seek to obtain full reimbursement of such costs from any licensee. All out-of-pocket costs shall be paid: 40% by CRF and 60% by Medical Center. Medical Center agrees not to progress into National Phase patent prosecution without specific written approval from CRF unless the prosecution is fully reimbursed by a licensee. Medical Center agrees not to abandon any patent application claiming the INVENTION (except in favor of continuing application) without first notifying CRF at least 30 days in advance of any applicable deadline, and allowing said other owners the opportunity to prosecute such patent application.

4. Revenue Distribution. Revenue received by Medical Center from license fees, milestone payments, royalties, and patent prosecution reimbursements and the like from the INVENTION will be distributed as follows: first, the out-of-pocket expenses of all the parties not already

reimbursed by licensee(s) will be reimbursed; second, Medical Center will receive a 10% management fee calculated on out-of-pocket expenses; third, the remaining monies will be distributed as follows: 60% to Medical Center and 40% to CRF who will each distribute to only their own inventors per their institutions' royalty sharing policies. Monies will be disbursed within 90 days of receipt.

5. Publicity. No party shall use or permit to be used the name (or any adaptation thereof) of any other party or of any staff member, officer, employee or student of any other party in any advertising, promotional or sales literature, publicity or in any document employed to obtain funds or financing without the prior written approval of the party or individual whose name is to be used. For Medical Center, such approval shall be obtained from Vice President, Science and Technology and for CRF, President, Cornell Research Foundation, Inc.

6. Choice of Law. This Agreement shall be governed by and construed and interpreted in accordance with the laws of the Commonwealth of Massachusetts.

7. Infringement. In the event that patents claiming the INVENTION are infringed by a third party other than a licensee, CRF and Medical Center shall determine, jointly with any licensee(s), a mutually beneficial course of action and division of expenses and recoveries at the time the parties learn of such infringement.

8. Records. Medical Center shall keep accurate accounts of all expenses and all proceeds received from each licensee of the INVENTION and shall permit CRF upon reasonable notice to allow a certified public accounting firm, acceptable to Medical Center, to examine its books and records in order to verify the payments due or owing under this Agreement.

9. Severability. If any provision(s) of this Agreement are or become invalid, are ruled illegal by any court of competent jurisdiction or are deemed unenforceable under then current applicable law from time to time in effect during the term hereof, it is the intention of the parties that the remainder of this agreement shall not be effected thereby. It is further the intention of the parties that in lieu of each such provision which is invalid, illegal or unenforceable, there be substituted or added as part of this Agreement a provision which shall be as similar as possible in economic and business objectives as intended by the parties to such invalid, illegal or enforceable provision, but shall be valid, legal and enforceable.

10. Notices. Any notice required or permitted to be given to the parties hereto shall be deemed to have been properly given if delivered, in writing, in person or mailed by first-class certified mail to the following addresses, or such other addresses as may be designed in writing by the parties from time to time during the term of this Agreement.

CRF: President
Cornell Research Foundation
20 Thornwood Drive
Suite 105
Ithaca, New York 14850

Medical Center: Vice President of Science & Technology
Office of Corporate Research
Beth Israel Deaconess Medical Ctr.
1 Deaconess Road
Boston, MA 02215

11. Termination. Provided the INVENTION is not licensed or optioned hereunder, either CRF or Medical Center may terminate this Agreement and its rights and obligations hereunder by providing sixty (60) days written notice of termination to the other party. The terminating party, after providing notice of its intentions, will proceed to meet all obligations, financial or otherwise, to the other party by the end of the sixty (60) day notice period, including any steps reasonably necessary to perfect legal rights to the INVENTION in the remaining party and to enable the remaining party to properly manage any pending or issued patents. Upon termination each party shall have all of the rights to which it was entitled prior to execution of the Agreement.

12. Term. Unless terminated as provided above, this Agreement shall terminate with the expiration of the last to expire patent issued on said INVENTION, on abandonment of all patent applications on the INVENTIONS, (provided such abandonment is by mutual consent) or upon the termination of all license agreements relating to the INVENTIONS, whichever event shall last occur.

13. Reimbursement of Patent Expenses. If either CRF or Medical Center elects to terminate in the manner provided above, both parties, including the terminating party, shall have the right to license its right and both parties shall maintain the right to practice the INVENTION and patent rights for its internal research, clinical and educational purposes. However, if the remaining party subsequently licenses the INVENTION and receives royalty or other income thereunder, the party having terminated this Agreement shall be entitled to have any unreimbursed patent expenses that were incurred while the Agreement was in force paid from such income, but only after the remaining party has recovered its expenses in full. After the out-of-pocket patent expenses of the terminating party have been reimbursed in full, that party shall have no further rights whatsoever to any income from the License Agreement executed by the non-terminating party.

14. Assignment. Neither party may assign this Agreement without the written permission of the other party.

15. Waiver. No waiver by either party hereto of any breach or default of any of the covenants of this Agreement shall be deemed a waiver as to any subsequent or similar breach or default.

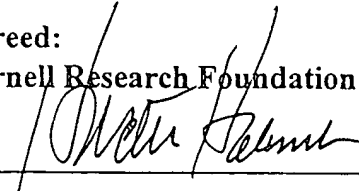
16. Entire Agreement. This Agreement constitutes the entire Agreement between the parties covering the subject matter hereof. All prior agreements respecting the subject matter hereof are void. No amendment of this Agreement shall be binding upon the parties unless mutually agreed to, executed in writing and signed by both parties.

Agreed:

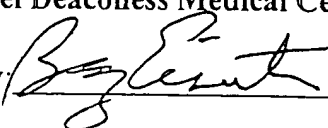
Cornell Research Foundation

Beth Israel Deaconess Medical Center:

By:

 Date July 20 '98

By:

 Date 7/20/98

Name:

H. WALTER TAUSSLER

Name: Barry Eisenstein

Title:

PRESIDENT

Title: Vice President of Science & Technology

**Appendix A
INVENTION**

Title: "Methods of evaluating transplant rejection"

Inventors: Terry Strom, Lauro Vasconcellos (of Medical Center)
and Manikkam Suthanthiran (of CRF)

INVENTION shall mean:

- (1) the patents and patent applications which relate to methods and/or compositions for "Methods of evaluating transplant rejection", U.S. Application No. USSN: 08/937,063 filed September 24, 1997, (Attorney Docket No. BIDMC97-01 and CRF ref: CRF D-2221) and any and all regular applications, continuation, continuation-in-part and divisional patent applications thereof, all patents issuing therefrom including any re-issue or re-examination thereof and all foreign counterpart patent applications and patents of the foregoing.